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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,885	06/26/2000	Stephen William Watson Michnick	Oddy 004	2144

7590 12/15/2003
Isaac A. Angres
Suite 301
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EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/603,885

Applicant(s)

MICHNICK ET AL.

Examiner

Padmashri Ponnaluri

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1,3,4,18,19 and 21-33.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


PADMASHRI PONNALURI
PRIMARY EXAMINER

Padmashri Ponnaluri
Primary Examiner
Art Unit: 1639

Continuation of Advisory action: 09/603,885

The proposed amendments filed on 11/24/03 have been considered and would not overcome the rejections of record.

a) the scope enablement rejection of record has been maintained for the reasons of record.

Applicants argue that in view of the priority claimed to US patent application 09/017,412, it is submitted that there is sufficient guidance in the application. Applicants in response to the rejection address that the proposed priority application 09/017,412 teaches how to select, enable and design a reporter molecule. Since no priority to the 09/017,412 is granted and even further since the '412 application does not disclose the subject matter adequately under 35 USC 112, first paragraph for the reasons discussed in the earlier office action the priority to the filing date of the '412 application is denied.

b) And further the incorporation of the application 09/017,412 disclosure into the specification by a later amendment is considered as new matter.

c) Art rejection of claims 1, 3-4, 18-19, 21-33 as being anticipated by or obvious over Pelletier et al has been maintained for the reasons of record.

Applicants arguments that the reference publication date is not more than year to the effective filing date of the '964 filing date and therefore can not be used against any application parented by '964. Applicants arguments have been considered and are not persuasive since priority to the '964 application has not been granted, and further even if the priority date of the '964 has been granted, the obviousness rejection is maintained for the reasons of record. Applicants have not addressed the obviousness rejection.

d) Applicants arguments in response to the anticipatory rejection and obviousness type double patenting rejection of claims over '964 patent ('412 application) have been considered and are not persuasive.

Applicants argue that since the instant application claims priority to the '964 patent or '412 application the rejection should be withdrawn. Since the priority to the '964 patent or '412 application is not granted the rejections of record have been maintained for the reasons of record.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Pp
11 December 2003